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09/934,973	08/22/2001	Timothy P. Croughan	98A9-USC1 Croughan	8353

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EXAMINER

KRUSE, DAVID H

ART UNIT PAPER NUMBER

1638

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,973

Applicant(s)

CROUGHAN, TIMOTHY P.

Examiner

David H. Kruse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/04/2004, 03/07/2005 and 07/14/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-69, 71, 72 and 82-84 is/are pending in the application.
- 4a) Of the above claim(s) 63, 65, 67, 69, 71, 72 and 82-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62, 64, 66 and 68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action is in response to the Amendment to the claims filed on 14 July 2005 and the Remarks filed on 4 October 2004 and 7 March 2005.
2. The rejection of claims 75, 77 and 79 under 35 U.S.C. 103(a) as being unpatentable over Terakawa *et al* 1992 (Japan. J. Breed. 42:267-275) in view of Dietrich (U.S. Patent 5,767,361, filed 8 June 1992) is now moot, said claims have been cancelled.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

4. Newly submitted claims 82-84 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The instant method claims are directed to an invention non-elected without traverse in the response filed on 14 January 2003 in Paper No. 4.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 82-84 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR § 1.142(b) and MPEP § 821.03.

5. Claims 63, 65, 67, 69, 71 and 72 remain withdrawn from consideration pursuant to 37 CFR § 1.142(b) as being drawn to a nonelected invention, there being no

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allowable generic or linking claim. Election was made without traverse in the response filed on 14 January 2003.

6. Applicant's remarks concerning rejoinder of the withdrawn claims have been considered (page 6 of the Remarks filed 7 March 2005, and pages 3-4 of the Remarks filed 4 October 2004). Rejoinder of the withdrawn (nonelected) claims directed to methods of using the product claims of the elected invention, will be considered at such time that the product claims are considered allowable. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR § 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §§ 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims

in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996).

Claim Rejections - 35 USC § 112

7. Claims 62, 64, 66 and 68 remain rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is repeated for the reason of record as set forth in the last Office action mailed 3 June 2004. Applicant's arguments filed 7 March 2005 and 4 October 2004 have been fully considered but they are not persuasive.

The instant claims remain rejected for lack of adequate written description because they are directed to any progeny of the rice plant having ATCC accession number PTA-904 having tolerance to an acetohydroxyacid synthase herbicide ("that grow without significant injury in the presence of the herbicide"). As the invention of claim 62 appears to be directed to a progeny produced from an undefined number of crosses or back-crosses, Applicant has failed to adequately described the invention as broadly claimed. Applicant does not describe what structural feature of the rice plant having ATCC accession number PTA-904 has that confers the function feature of the claimed invention. The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying

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characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus (see i)(C), above). See *Eli Lilly*, 119F.3d at 1568, 43 USPQ2d at 1406. Since Applicant does not adequately describe the correlating structural feature of the rice plant having ATCC accession number PTA-904, one of skill in the art would not be able to recognize what Applicant was in possession of at the time of the instant invention. See *Vas-Cath Inc. v. Mahurkar* 1991 (CA FC) 19 USPQ2d 1111, 1115, which teaches that the purpose of the written description is for the purpose of warning an innocent purchaser, or other person using a machine, of his infringement of the patent; and at the same time, of taking from the inventor the means of practicing upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is, or different from its ostensible objects, that the patentee is required to distinguish his invention in his specification.

Applicants response on pages 6-7 of the Remarks filed 7 March 2005 and page 4 of the Remarks filed 4 October 2004 do not particularly rebut this rejection, only stating that the amendment overcomes the rejection.

8. Claims 62, 64, 66 and 68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The invention appears to employ novel plants. Since the plant is essential to the claimed invention it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the plant is not so obtainable or available, the requirements of 35 USC § 112 may be satisfied by a deposit of the plant. A deposit of 2500 seeds of each of the claimed embodiments is considered sufficient to ensure public availability. The specification does not disclose a repeatable process to obtain the plant and it is not apparent if the plant is readily available to the public. It is noted that applicants have deposited the plant but there is no indication in the specification as amended in the preliminary amendment filed 22 August 2001 as to the term of the deposit under 37 CFR § 1.806.

(a) If the deposit was made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific strain has been deposited under the Budapest Treaty and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of the patent, would satisfy the deposit requirement made herein (see 37 CFR § 1.808).

(b) If the deposit was not made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 C.F.R. §§ 1.801-1.809, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

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- (i) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (ii) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- (iii) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer (see 37 CFR § 1.806);
- (iv) a test of the viability of the biological material at the time of deposit (see 37 CFR § 1.807); and,
- (v) the deposit will be replaced if it should ever become inviable.

Claim Rejections - 35 USC § 102

9. Claims 62, 64, 66 and 68 remain rejected under 35 U.S.C. § 102(b) as being anticipated by Terakawa *et al* 1992 (Japan. J. Breed. 42:267-275). This rejection is repeated for the reason of record as set forth in the last Office action mailed 3 June 2004. Applicant's arguments filed 7 March 2005 and 4 October 2004 have been fully considered but they are not persuasive.

Claim 62 is directed to a product-by-process wherein the process uses the rice plant having ATCC accession number PTA-904. As the invention of claim 62 appears to be directed to a progeny produced from an undefined number of crosses or back-crosses, the instant claims appear to be anticipated by Terakawa *et al*. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by

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a different process, if the process of making the product fails to distinguish the two products. The Office does not have the facilities and resources to provide the factual evidence needed in order to establish that the product of the prior art does not possess the same, material, structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is on the Applicant to provide that the claimed product is different from those taught by the prior art and to establish patentable differences. See *In re Best* 562 F.2d 1252 USPQ 430 (CCPA 1977) and *Ex parte Gray* 10 USPQ 2d 1922 (PTO Bd. Pat. App. & Int. 1989).

Applicant argues that the reference does not teach or suggest the rice plant PTA-904 (page 8 of the Remarks filed on 7 March 2005). This argument is not found to be persuasive for the reasons given above.

Double Patenting

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. § 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. § 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. § 101.

11. Claims 62, 64, 66 and 68 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim 16 of prior U.S. Patent No. 6,943,280 B2. This is a double patenting rejection. The preamble of claim 16 of prior U.S. Patent No. 6,943,280 B2 recites inherent properties of the rice plant having ATCC accession number PTA-

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904, and claims 64, 66 and 68 of the instant application recite additional inherent properties. Hence, the Examiner interprets that instant claims as encompassing the same subject matter as that already patented in claim 16 of prior U.S. Patent No. 6,943,280 B2.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR § 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR § 3.73(b).

13. Claims 62, 64, 66 and 68 are rejected under the judicially created doctrine of double patenting over claim 11 of U. S. Patent No. 6,943,280 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The subject matter of claim 11 of U. S. Patent No. 6,943,280 B2 encompasses the subject matter of the instant claims in addition to a transgenic rice plant, hence the patented claim renders obvious the subject matter of the instant claims.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. No claims are allowed.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached at (571) 272-0745. The fax telephone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-0547.

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER



David H. Kruse, Ph.D.
21 September 2005

17. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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